UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,736	09/29/2000	Gregory T. Osterhout	11889RR/56130.000011	2264

7590 11/08/2005	**EXAMINER**
Hunton & Williams	RYMAN, DANIEL J
1900 K Street NW	

ART UNIT	PAPER NUMBER
2665	

Washington, DC 20006-1109

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/671,736	OSTERHOUT ET AL.
	Examiner	Art Unit
	Daniel J. Ryman	2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 October 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed on 6 October 2005 have been fully considered but they are

not persuasive. On pages 3-6 of the Response, Applicant asserts, with respect to claims 1 and 13,

that "Pickering does not teach or suggest any feature or functionality that (1) 'receiv[es] a call

initiation request, via a first interface to a network-enabled telephone device,' or (2) 'selectively

initiat[es] a call from the network-enabled telephone device as at least one of a telephone call and

a data connection via at least one communications link according to at least one transmission

criterion.'" Examiner, respectfully, disagrees.

2.   Regarding issue (1), Pickering teaches that the user uses a telephone connected to a

computer in order to form a "single user interface capable of handling both IP and conventional

telephone calls" (col. 4, lines 34-57 and col. 5, lines 63-67). Pickering also discloses that the

"client may interface to the computer using his/her telephone 201 by virtue of modular cable

173" (col. 6, lines 8-9). When the user uses the telephone to signal to the computer that a call is

desired, the computer "receiv[es] a call initiation request, via a first interface to a . . . telephone

device." Therefore, Examiner maintains that Pickering discloses this limitation.

3.   Regarding issue (2), Applicant asserts that in Pickering "the call has already been

initiated" when the switching occurs. While Pickering does disclose that the call can be switched

after it has been set-up, Pickering nonetheless also discloses selectively initiating the call over

either the Internet or the ISDN/PSTN. Pickering teaches that, when an Internet call is desired, the

computer will check the available bandwidth in the packet-switched network using RSVP, and, if

sufficient bandwidth is not available, the call will be transferred to the ISDN or PSTN (col. 6,

lines 30-60). According to Newton's Telecom Dictionary, "[t]hrough RSVP, a user's quality of

service requests are propagated to all routers along the data path, allowing the network to

reconfigure itself to meet the desired level of service." Thus, because RSVP is used to ensure

that the resources required to complete a call are available before the call is attempted, RSVP

acts before a call is initiated rather than after the call is initiated. Therefore, Pickering discloses

that the computer selectively initiates the call from the telephone device as at least one of a

telephone call (ISDN/PSTN) and a data connection (Internet) via at least one communications

link (modem link) according to at least one transmission criterion (sufficient bandwidth).

4.   Applicant additionally asserts on page 7 of the Response that "Oran does not make up for

Pickering's deficiency in failing to disclose [the aforementioned claimed limitations]." However,

Examiner asserts that there are no deficiencies in Pickering, in light of the above arguments. As

such, Examiner maintains that the combination of Pickering and Oran discloses the

aforementioned claim limitations, as outlined in the rejection.

5.   Applicant further asserts on page 8 of the Response that "Examiner has not set forth a

proper motivation to combine the references." Examiner, respectfully, disagrees. Pickering

discloses that any telephone device that is capable of communicating with the sound and modem

cards of the PC will be sufficient for the practice of the invention (col. 4, lines 58-67). Oran

teaches the use of IP phones, where IP phones are capable of communicating with a PC. Since

Pickering discloses that any type of phone can be used that is capable of communicating with a

PC and Oran discloses a phone that is capable of communicating with a PC, it would have been

obvious to one of ordinary skill in the art at the time of the invention to use Oran's IP phones in

Pickering's system.

6.   Applicant also asserts on pages 8-9 of the Response that the combination of Pickering

and Oran does not disclose that the telephone device comprises a SIP-enabled telephone device.

Again, Examiner, respectfully, disagrees. As outlined above, the combination of Pickering and

Oran discloses the use of IP phones. Oran additionally discloses that SIP is a well-known

protocol used for VoIP. Therefore, it would have been obvious to one of ordinary skill in the art

at the time of the invention to use SIP since SIP is a well-known protocol used for VoIP.

7.   Given the above arguments, Examiner maintains that the claims are obvious in view of

the cited prior art.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 1-3, 6-9, 11-15, 18-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pickering et al. (USPN 6,628,666) in view of Oran (USPN 6,275,574).

10.   Regarding claims 1 and 13, Pickering discloses a system for adaptively placing a call via

one of a plurality of transmission modes, comprising: a first interface (interface between

telephone and computer) to a telephone device (col. 5, line 60-col. 6, line 12); a second interface

(internet interface or telephone interface) to at least one communications link (col. 5, line 60-col.

6, line 12); and a host (ref. 202: computer), communicating with the first interface and the

second interface, the host, after receiving a call initiation request via a first interface, selectively

initiating a call from the network-enabled telephone device as at least one of a telephone call and

a data connection via the at least one communications link according to at least one transmission

criterion (col. 6, lines 30-67).

Pickering does not expressly disclose that the first interface is to a network-enabled

telephone device; however, Pickering does disclose communicating over the internet using a

phone device (col. 5, line 60-col. 6, line 12). Oran teaches, in a telecommunications system, that

network-enabled telephones are well known (col. 3, lines 6-9) where it is implicit that these

phones are used for communication over packet networks. Thus, it would have been obvious to

one of ordinary skill in the art at the time of the invention to use a network-enabled telephone

device as the telephone device since these devices are known in the art as a way to direct

telephone calls over a packet network.

11.   Regarding claims 2 and 14, Pickering in view of Oran suggests that the network-enabled

telephone device comprises a SIP-enabled telephone device (Oran: col. 1, lines 28-32).

12.   Regarding claims 3 and 15, Pickering in view of Oran does not expressly disclose that the

first interface comprises a USB connection; however, Pickering in view of Oran does disclose

that the telephone and the host can be connected using a variety of different connections known

in the art (Pickering; col. 4, lines 44-67). Examiner takes official notice that a USB connection is

a very old and well-known way in the art to connect together two devices. It would have been

obvious to one of ordinary skill in the art at the time of the invention to use a USB connection

since USB connections are a very old and well known way in the art to connect together two

devices.

13.   Regarding claims 6 and 18, Pickering in view of Oran discloses that the host comprises a

computer (Pickering: col. 5, line 60-col. 6, line 12 and col. 6, lines 30-67).

14.   Regarding claims 7 and 19, Pickering in view of Oran discloses that the at least one

transmission criterion comprises at least one of cost, time of day, day of week, user-defined

routing data, packet delay and signal to noise ratio (Pickering: col. 3, lines 5-8 and col. 6, lines

30-67).

15.   Regarding claims 8 and 20, Pickering in view of Oran discloses that the call comprises a

telephone call (Pickering: col. 6, lines 30-67) and that the at least one communications link

comprises the public switched telephone network (Pickering: col. 5, line 60-col. 6, line 12 and

Oran: col. 3, lines 6-9 and col. 3, lines 31-40) where a network-enabled phone is connected to a

PSTN-IP converter (host) having an interface to the PSTN in order to connect a network-enabled

phone to the PSTN.

16.   Regarding claims 9 and 21, Pickering in view of Oran discloses that the call comprises a

data connection and the at least one communications link comprises the Internet (Pickering: col.

5, line 60-col. 6, line 12).

17.   Regarding claims 11 and 23, Pickering in view of Oran discloses that the host selectively

retries at least a data connection to reassess transmission conditions (Pickering: col. 6, lines 61-

67).

18.   Regarding claims 12 and 24, Pickering in view of Oran discloses that the at least one

communications link comprises a plurality of communications links, and the host selectively

activates one of the communications links according to the at least one transmission criterion

(Pickering: col. 6, lines 30-67).

19.   Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pickering et al. (USPN 6,628,666) in view of Oran (USPN 6,275,574) as applied to claims 4 and

16 above, and further in view of Alperovich et al. (USPN 6,728,215).

20.   Regarding claims 4 and 16, Pickering in view of Oran does not expressly disclose that the

first interface comprises a wireless interface. Alperovich teaches, in telecommunication system,

having a first interface comprise a wireless interface (col. 3, lines 10-28) where it is implicit that

this allows a user to communicate with a wireless phone. It would have been obvious to one of

ordinary skill in the art at the time of the invention to have the first interface comprise a wireless

interface since wireless connections enable greater mobility to a user.

21.   Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pickering et al. (USPN 6,628,666) in view of Oran (USPN 6,275,574) as applied to claims 4 and

16 above, and further in view of Bridgman et al. (USPN 6,523,062).

22.   Regarding claims 5 and 17, Pickering in view of Oran does not expressly disclose that the

host comprises a Wireless Markup Language module; however, Pickering in view of Oran does

disclose that a variety of data types can be exchanged with Pickering in view of Oran's inventive

system (voice, data, video) (Pickering: col. 7, lines 25-29). Bridgman discloses that Wireless

Markup Language is "an industry standard protocol specification created for mobile internet use"

(col. 1, lines 19-55). It would have been obvious to one of ordinary skill in the art at the time of

the invention to have the host comprise a Wireless Markup Language module since WML is an

industry standard protocol specification created for mobile internet use.

23.   Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pickering et al. (USPN 6,628,666) in view of Oran (USPN 6,275,574) as applied to claims 1 and

13 above, and further in view of Kuthyar et al. (USPN 5,768,513).

24.   Regarding claims 10 and 22, Pickering in view of Oran does not expressly disclose a

media management module, the media management module executing at least one of a cordless

telephone operation, an answering machine operation, a pager operation, an intercom operation,

and an audio/visual operation via the network-enabled telephone device; however, Pickering in

view of Oran does disclose that various types of information can be communicated over various

connections with Pickering in view of Oran's inventive system (Pickering: col. 7, lines 25-29).

Kuthyar teaches using a media management module to execute an answering machine operation

such that messages can be left for a called party (col. 1, line 64-col. 2, line 35). It would have

been obvious to one of ordinary skill in the art at the time of the invention to have a media

management module, the media management module executing at least one of a cordless

telephone operation, an answering machine operation, a pager operation, an intercom operation,

and an audio/visual operation via the network-enabled telephone device in order to allow

messages to be left for a called party.

Conclusion

25.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Curry et al. (USPN 6,078,582) see entire document which pertains to determining

whether a call should be completed on the PSTN or Internet depending on the call requirements

of a particular call. Beyda et al. (USPN 5,995,607) see entire document which pertains to

determining whether a call should be completed on the PSTN or Internet depending on the call

requirements of a particular call. Farris (USPN 6,064,653) see entire document which pertains to routing a voice call over the PSTN during periods of unacceptable network conditions.

26.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 7:00-4:30 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel J. Ryman
Examiner
Art Unit 2665

**HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**